



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,927	09/19/2001	Michael Dean	015280-382100US	6490

7590 12/13/2004

Kenneth A Weber  
Twonsend & Townsend & Crew LLP  
8th Floor  
Two Embarcadero Center  
San Francisco, CA 94111-3834

EXAMINER

HUFF, SHEELA JITENDRA

ART UNIT PAPER NUMBER

1642

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/856,927

### Applicant(s)

DEAN ET AL.

### Examiner

Sheela J Huff

### Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 21-223 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,22 and 23 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on 11/22/04 has been considered. Applicant's arguments are deemed to be persuasive-in-part.

Claims 1-2 and 21-23 are pending.

The rejection of claims 1-2 and 21-23 under 35 U.S.C. 112, first paragraph, (new matter) is withdrawn in view of applicant's amendment.

### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 remains rejected under 35 U.S.C. 102(a) as being anticipated by Doyle, Proceeding of the American Association for Cancer Research 39:657 (3/98) (reference

AE on IDS filed 7/15/03 as evidence by Doyle et al PNAS USA 95:15665 (12/98) (reference AJ on IDS filed 7/15/03). The reasons for this rejection are of record in the paper mailed 7/21/04.

Claims 1 and 2 remain rejected under 35 U.S.C. 102(a) as being anticipated by Doyle, Proceeding of the American Association for Cancer Research 39:657 (3/98) (reference AE on IDS filed 7/15/03 as evidence by Doyle et al PNAS USA 95:15665 (12/98) (reference AJ on IDS filed 7/15/03). The reasons for this rejection are of record in the paper mailed 7/21/04.

Claim 1 remains rejected under 35 U.S.C. 102(e) as being anticipated by Ross et al US 6313277 (which has priority to 60/073763, filed 2/5/98). In view of applicant's amendment, the rejection re-written. The reasons for this rejection are of record in the paper mailed 7/21/04.

Claims 1 and 2 remain rejected under 35 U.S.C. 102(e) as being anticipated by Ross et al US 6313277 (which has priority to 60/073763, filed 2/5/98). ). In view of applicant's amendment, the rejection re-written. The reasons for this rejection are of record in the paper mailed 7/21/04.

Response to Applicant's arguments

Applicant argues that the examiner's position is inconsistent with the standards

set forth in the MPEP and cites portions of 715.02/715.03. A complete reading of 715.02 and into 715.03 states the standard for generic claims. Applicant states that in 715.03 the MPEP allows for applicant to antedate a reference indirectly by showing completion of one or more species which puts them in possession of the claimed genus and that the "test is whether the species completed by applicant prior to the reference date...provided adequate basis for inferring that the invention has generic applicability." According to the arguments and the declaration filed 11/22/04 (1) the existence of naturally occurring homologues variants were known (2) that the inventors were the first to clone the sequence for MXR1 and that (3) functional assays were also available to verify the biological activity of the ABC protein. Applicant's specification/declarations only disclose that applicant had possession of the full-length sequences and not variants or naturally occurring homologues. According to the MPEP the test is whether the full length provides adequate basis for inferring that the invention has generic applicability. Applicant has not specifically shown possession of any variant or homologue that possess the activity of the full length. There are hundreds of sequences that would comprise the genus of "at least 95% identity" to SEQ ID NO. 2. Applicant has only shown one species. Because the genus is clearly a large genus, one is insufficient.

***Claim Rejections - 35 USC § 112***

Claims 22 and 23 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It appears that the polynucleotide sequence and the nucleic acid sequence in claim 1 are the same. In view of this, claims 22 and 23 are duplicates.

Applicant argues that changes have been made to claims. The changes were to correct grammatical errors only. The only difference in the words between claim 22 and 23 is "polynucleotide" versus "nucleic acid". These read as the same. It is not clear what different, if any, applicant is trying to claim.

### ***Allowable Subject Matter***

Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1642

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J Huff whose telephone number is 571-272-0834. The examiner can normally be reached on Mondays and Thursdays from 5:30am to 2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sheela J Huff  
Primary Examiner  
Art Unit 1642

sjh